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IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1995

JOSEPH S. MARESCA
PETITIONER

VS.

COMMISSIONER OF PATENTS ET AL.
RESPONDENT

PETITION FOR A WRIT OF CERTIORARI
ON THE UNITED STATES COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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Questions Presented for Review

In the case of Griggs v. Duke Power, U.S. Reports, 1971, 401, 424(a), this court has said that the employer bears the burden of proof that any given requirement for employment is related to the job. The facts of this case show that the United States Patent Office has awarded 3 of 37 credits under Cat B Option 4-cert. record 060 of the DDC without ever having prepared a job description for a patent agent or having validated the job tasks scientifically. As a consequence of this lack of standardized human resource evaluative procedures, the petitioner was declined numerous times to sit for the patent examination. No expert in the art of the petitioner's qualifications has ever been commissioned by the PTO to comment on the record. The Directors of the OED at the time of the Oct. 1991 application and currently have been natural sciences experts unfamiliar with the petitioner's computer sciences-engineering in nature matter on the cert. record 060 which contains algorithms/ operations research courses and industrial engineering courses. The said declinations of the PTO are undocumented as to their relationship to a formal syllabi,curricula or standards of professional societies set forth in the lower court record cert. record 801-3 and argued extensively in the Informal Brief and Appendix dated 1-18-1995 Appeals Court. The facts show that up to 37 added credits under Cat. B Option 4 as defined on cert.record 060 could have been granted instead of the 3 awarded. The PTO made a literal interpretation of Cat A Industrial Engineering; whereas, the petitioner has proved over 48 credits of Industrial Engineering (IE) matter with reference to the 12/92 IE curriculum survey published as the result of an intensive survey. PTO has never formally commenced a survey of IE content nor validated its interpretation of IE.

Questions Presented For Review-cont.

As part of the application process, the petitioner bolstered the record with statements from experts, relevant professional literature of the Institute of Industrial Engineers, copies of course syllabi cross-referenced to the law as it was set forth in 1991, a contradictory public hiring announcement under which the petitioner would qualify, the petitioner's allowed patent, the petitioner's teaching of a sophomore computer sciences course for undergrads and grad students, a statement commenting on the petitioner's knowledge of computer sciences-artificial intelligence made by a National Science Foundation reviewer, petitioner's CISA license to practice the review of computer systems and a large body of technical documentation set forth in pp. 1-821 of the lower court record. To this date, the Director of OED has refused to enter the petitioner's name on the patent examination roster.

Contrary to the Hines for Sevier v. HHS 940 F. 2nd 1518, 1528 Fed Cir 1991 case, the HHS has placed the name of the petitioner on its computer sciences consultant file after having evaluated the same information as the Director of OED.

The Appeals Court did not cite the petitioner's Advanced Professional Certificate in Computer Applications and omitted the term Bachelor of Science in describing the Manhattan College degree. In addition, the District Court for the District of Columbia did not cite the computer sciences-engineering in nature credit which is critical to the entrance criteria in this case.

In addition, the lower courts did not articulate the fine distinction between determining qualifications in 37 CFR 10.7 as against mandating educational content which is the sole purview of the states. The Supreme Court is asked to set the dividing line of residual powers as it applies to determining qualifications. New York State has a degree content statute 3.47 which it enforces rigidly with examinations of all colleges/universities in the State of New York once every 5 years. In fact, the Division of Evaluation has sent a letter to Judge Harris of the DDC describing the evaluation of Manhattan College degree programs and citing the 1989 visit as the most recent one . (Proceedings of DDC #27-Letter of 3-15-1994)

The Department of Education Organization Act provides:

> "The establishment of the Department of Education shall not increase the authority of the federal government over education or diminish the responsibility for education which is reserved to the states and other instrumentalities of the States." 20 USC Par 3403 (a)

In addition, from 1787-1925 the Patent Office was functionally separated from the Commerce Department itself. Indeed, HR 1732 on the Patent Reauthorization Reform Act seeks reforms in the Patent Office; however, the petitioner requests equitable relief now.

Parties Involved

The petitioner, Joseph S. Maresca seeks entrance into the next available examination for the registration of patent agents/attorneys. He is a member of the American Institute of Certified Public Accountants, a CPA and a Certified Information Systems Auditor. This information is contained pervasively throughout the record of the lower courts. He seeks entrance into the patent examination having over 48 credits of Industrial Engineering and over 40 credits of computer sciences matter under Cat B Option 4. He has taught collegiate computer sciences at Manhattan College. He has patented an earthquake monitoring device.

The respondents are the Commissioner of Patents and various designees who act on behalf of the Commissioner in the various declinations. The signed declinations are from the Director of OED, Director of Interdisciplinary Programs and various legal liaisons. The party with the statutory discretion is the Secretary of Commerce under 35 USC 31. The Solicitor General is the attorney who will respond to this lawsuit.

General Synopsis

This case involves the qualifications of Joseph S. Maresca to be admitted to the Patent Examination on the basis of scientific educational qualifications provided for by 35 USC 31 and 37 CFR 10.7 and general standards of personnel evaluation/qualifications used in industry and academe. The appellant is both a Certified Public Accountant and Certified Information Systems Auditor. (2 licenses) The reference to Joseph S. Maresca CPA, CISA is made in various parts of the District Court of the District of Columbia proceedings pp. 1-821.

The requirements for a CISA are published nationwide and throughout the 35 member countries where the CISA designation is recognized. A CISA must be competent in the following domains generally:

- o Domain 1 Audit Standards
- o Domain 2 Organization and Management
- o Domain 3 Information Processing Facility Operations
- o Domain 4 Logical Access and Environment
- o Domain 5 Continuity of Operations
- o Domain 6 Operating Systems Software Devel.
- o Domain 7 Application Software Development Acquisition and Maintenance
- o Domain 8 Application Systems

The applicant's most recent institutional employer in proximity to the 10-28-91 application is the Examining Division of the American Institute of CPAs. His services were utilized to score sections of the CPA exam which included statistics and computer sciences questions. In 5 engagements, he corrected portions of 30,000 exam papers including exams written in Spanish (Puerto Rico).

The applicant possesses over 40 credits in Cat B Option 4 as at 10-28-1991. The Cat B Option 4 technical matter is computer sciences-engineering in nature to include algorithms, computer software with lab, computer fundamentals, operating systems, computer architecture, theoretical models and representations plus economics other than technology. The statutory Bachelor of Science which the appellant possesses is titled "Quantitative Business Analysis" and contains courses in intermediate calculus, ordinary differential equations, operations research, quantitative models, concepts of the computer, topics in science, econometrics and a manufacturing simulations course. There are over 15 graduate school credits in the computer sciences together with a published thesis made generally available by New York University. The topic of the thesis is Minicalculators. It covers some basic computer architecture, economic models of the semiconductor market, basic differences in the component structure and a cost analysis. In addition, Joseph S.Maresca has an issued patent which is part of the lower court record. 37 of 40 credits under Cat B Option 4 are in contention as well as Cat A-Industrial Engineering.

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Appendix: "Lodge It Materials"

Certified Record Pages Referred To In the Writ (Proceedings 8: 93-226 PLF) 151,230 2,3,30-35,43-6,59-65 119,127-9,131-4 153,169-72,208-15,329-31,337 343,369-71 448,450,475 485-518,785 801-3

PTO Personnel Vacancy Announcement

P. 41 of Article by Gary Ferguson 12/92 IE(Industrial Engineering)

P. 92 of DDC Informal Brief Appendix NSF Comments

VCR Tape sent under separate cover "Con Edison Ad on IE"

Table of Statutes & Authorities

P-Writ
AP-Appendix
CR-DDC Rec.

Federal	Content
U.S. Constitution 10th Amendment	Residual Powers P. 16
Department of Education Organization Act 20 USC 3403(a)	Responsibility for Education Reserved for States P.16
35 USC 31 (1991 law)	Provides by approval by Commerce Secy to set forth regs. for pat.practice P.29, CR686
37 CFR 10.7 (1991 law)	Cat A and Cat B Op.4 law at 10-28-1991 P.4,5,18-9,22,29
Federal Case Law Albermarle v. Moody U.S.Reports 6-25-75 p.422	Standards demonstrate job relevance
Anderson v. Liberty Lobby 477 U.S. 242,252 ('86)	Non-PTO case P.10
Camp v. Pitts 411 U.S. 138, 142, 1973	National Bank Organized P.10,AP14
Cupples v. Marzall 101 F. Suppl 579	Grading of Exam P.10
Florida Power and Light Co. v. Lorion 470 US 729 1985	Nuclear Regulatory Commission Case P.10
Gager v. Ladd 212 F Suppl 671,673 DDC '63	Merchant marine courses P.10,25-6,29 AP14,15

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Federal	Content
Griggs v. Duke Power U.S. Reports '71, 401, 424(a)	Employer burden to show requirement is job related P.i,9,26 P.30
Hines for Sevier v. HHS 940 F. 2nd 1518, 1528 Fed Cir 1991	Child measles case P.9, AP14
Leeds v. Mosbacher 732 F. Suppl. 198,200	Superceeded by current law allowing patent examiners exam waivers AP14-16
MVMA v. State Farm Mutual Insurance Co 463 , U.S.29 '83	Department of Transportation case P. 10
U.S. v. Georgia Power Fifth Circuit Court of Appeals, 1973	Employer validation study is irrelevant since it did not correspond to actual decision-making on the job P. 9, 30

State Laws	Content
New York State 3.47	B.S. Degree content P. iii, 7
DDC Proceedings 27	Letter from NYS Div. of Evaluation which explains the Commissioner's review of Manhattan College P. 7,10

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State Laws	Content
Sheldon College v. State Board 48 NJ 501 226 A 2d 612, 1967	Licensing may be done by those doing the training. P. 8
Appl. of Bay 233 OR 601 378 P 2nd 558 '63	The trend is to accept broader delegations where generalized standards are a goal
School District v. State Board 176 Neb 722 127 NW 2nd 458 '64	Generalized guidelines with a legislative plan suffices to meet constitutional standards P.8
Tecumseh School District v. Throckmorton, 194 Ka. 519, 195 Kan, 144,403 P 2nd 102 '65	Authority granted by state constitution may not be withdrawn P.8
W.Virginia Board of Ed v. Hechler 376 SE 2nd 839 52 Educ. LR 369 W. Virginia 1988	" "
Spaulding v. Illinois College Board 64 Ill. 2d 499, 356 NE 2d 339	A state's interest in education is so pervasive-it may act at will P.8

The constitutionality of an act of Congress is being questioned and; therefore, 28 USC 2403a applies. Notification forms to the Attorney General and the State Attorney General apply.

The constitutionality of NYS Law 3.47 which governs technical degree matter is being called into question. Neither the U.S. Court of Appeals nor the District Court for the DC certified to the NYS Attorney General the fact that the constitutionality of a NYS statute had been drawn into question. Judge Stanley S. Harris of the DDC allowed into the record a letter from the Division of Evaluation of the NYS Education Department. The letter explained the NYS law and its evaluation by the Commissioner of NYS education. All of these details are explained in the lower court DDC Proceedings 00iv R27.

The Proceedings of the DDC show the following on page 00iv item 27.
Case 93-226 SSH, PLF

3-31-94	Item 27	Letter dated 3-15-94 to Judge Harris from Donald Nolan regarding Joseph S. Maresca degree requirements in NYS "Let This Be Filed" (fiat HARRIS,J (dot)

The case 93-226 PLF and SSH was transferred from Judge Harris to Judge Friedman 7-1-94 Proceedings Item 28

Note Proceedings 6 of the Appeals Court is a corrected proceedings of the lower court record R37 erroneously labelled as a defendant's motion. This is plaintiff's motion.

Table of Citations and Authorities

In the 12-23-94 opinion, Judge Paul Friedman addressed the NYS law and evaluative process. The judge stated:

"Second, he argues that the PTO's decision is an invalid encroachment on states' rights because it impinges on New York's laws that set educational standards. Mr. Maresca's additional claims lack merit. Congress delegated to the Commissioner the responsibility for setting the qualifications required of persons seeking to be registered to practice before PTO."

On page 2 of Judge Friedman's 12-23-94 decision, he cited the law only partially applicable to the application on the certified record 0059 and failed to cite the computer sciences-engineering in nature law on the cert.record 60.

I. Facts

The record shows that on 10-28-1991, Joseph S. Maresca submitted an application for the April 1992 exam. A portion of this application is shown on the certified record 0002,0003. The application shows the name, birth date of 1-14-1952 and is supplemented with original transcripts of Manhattan College and NYU on the certified record 0151 and 0230. The Manhattan College degree says "Bachelor of Science in Quantitative Business Analysis granted 5-19-1973 cum laude". The NYU transcript covers multiple programs. The course B10.2207 already credited by PTO is on this transcript. The Advanced Professional Certificate in Computer Applications '76 is also listed on this transcript certified record 0151. The transcripts have been reproduced in the accompanying materials labelled "Lodge It". The Advanced Professional Certificate Program at NYU is explained on the certified record 473.
The Manhattan College program is explained on the certified record 0119. This program includes "science" and "technical". Accordingly, the degree was changed to a Bachelor of Science to reflect the recently mandated technical content in the degree program. The algorithms courses taken at Manhattan College are shown on certified record 0030. These are 45-307, 45-407, 45-408. The certified record 167 and 172 references algorithms. Certified record 169-172 references theoretic models both Cat B Option 4 credit. The certified record 448 affirms the use of the Wagner text by the Registrar. This is 9 of the 40 credits in contention.

The course NYU B10.2207 CR131,151 credited by the PTO brings this number to 12 of the 40 credits under Cat B Option 4. CR211-215 There is a concurring expert opinion from Dr. Mc Callum, President of the Operations Research Society of America on certified record 127-9 as to the operations research courses.
The petitioner's teaching of Concepts of the Computers at Manhattan College is on the CR 498-518. The contract of employment is on CR 499 of the lower court record. The syllabus on CR 498 shows intensive coverage of BASIC language programming- 10 lectures, 10 lectures on systems design (Corporate Planning, Marketing, Engineering, Manufacturing...) Teaching of the BASIC language does not duplicate the teaching of FORTRAN already credited CR 210, 214 and 215.
In addition, CR 208, 209 is a sample exam distributed by the College.
The course taught by the petitioner tests the following on CR (certified record) 208.

- o Question 2 on programming of BASIC,FORTRAN
- o Question 3 on machine intelligence
- o Question 8 on encryption
- o Question 11 on network design and the achievement of maximum throughput

This course should be credited because it teaches multiple Cat B Op 4 areas CR60; such as, networks, software with lab, programming with lab.
The inclusion of this course brings to 15 the number of credits of the 40 required under Cat B Option 4 of the 1991 law CR60.
The "Business Policy course" 45-406 on CR30 is an "interdisciplinary study utilizing case studies and participation in a computerized simulation".
The computerized simulation is coverage of algorithms because algorithms generate computerized simulations. The expert opinion on CR 127-129 covers this course. This totals 18 of 40 credits under Cat B Op. 4.

The Manhattan College transcript of courses in algorithms, simulations and concepts of the computer is cemented with 4 years work experience at the college computer lab. This 4 years work experience is referenced on CR 0065. The Court may infer a very significant computer lab component in the total educational experience. A portion of CR 0065 is reproduced below: bottom text

> " I was hired as an instructor at Manhattan College because I had 4 years experience at the Manhattan College Computer Laboratory. "

The Manhattan College contract of employment as a teacher is on the certified record CR499-518.

On the certified record CR176, there is a CISA (Certified Information Systems Auditor) designation. This designation is affixed to the name in other portions of the record. A CISA must have knowledge in the domains explained earlier. These domains include operating systems and software programming which are Cat B Op. 4 creditable matter. Thus far, 18 of the 40 credits are described under Cat B Option 4. The petitioner will take the argument to the NYU transcript CR151 and course descriptions CR 131-134. There is an expert opinion of Dr. Uretsky for courses B20.3318 Systems Analysis and Design and B20 3364 Managing the Systems and DP (Data Processing) Function.

Dr. Uretsky states:

> "These are advanced courses in which students must demonstrate proficiency using advanced technologies... I feel safe in saying that students received intensive training in both of these areas."

The course catalog on CR 131-134 describes B20.2312 Introduction to Systems Analysis and Design , B20.3318 Advanced Systems Analysis, B20.3364 Managing the Systems and Data Processing Function and B20.3360 Social Consequences of Information Tech. The certified record 627-631 shows that this course is a report of the "Project on Databanks of the Computer Science and Engineering Board of the National Academy of Sciences" . How can this not be creditable as technical matter under Cat B Option 4?

The addition of B20.2312, B203318, B20.3364 and B20.660 adds another 12 credits(bring the running total from 18 to 30 of the 40 credits under Cat B Option 4 CR60.)

The portion of the certified record dealing with the computer sciences credit will be repeated here. CR 60 Par 1 states:

"Also, under Option 4, computer sciences which are computer engineering in nature will be accepted. Such courses would include courses that provide in depth knowledge of computer science, including digital computer system architecture and system software organization, the representation and transformation of information structures and the theoretical models for such representations and transformations. Accepted courses would include linear circuits, logic circuits,networking, fundamentals of computer science,algorithms, data structures,software design with lab, programming languages with lab, operating systems and computer architecture."

The law on CR60 governing Cat B Option 4 credit for computer sciences continues by excluding matter not creditable.

"The following courses are not accepted as demonstrating scientific and technical training: science courses for non-science majors, astronomy, mathematics courses, high school level courses, courses relating technology to politics or policy, courses offered by corporations to corporate employees, management courses, automotive repair and maintenance courses, radio/operator licenses, courses taken on a pass/fail basis, audited courses, home or personal independent study courses, courses to develop manual, processing or fabrication skills, economics of technology, courses in the history of science, engineering and technology, courses on how to use computer software, and courses which do not provide scientific and technical training. Also not accepted are courses which repeat or which are substantially the same as or are lessor included courses which you have already been given credit."

Economics of technology courses are not creditable; however, the law does not exclude all economics courses because a patent agent must describe the economic sources of demand/supply of component parts to recreate the specification by an ordinary artisan skilled in the art to which the application pertains. Therefore, the macro-economics is creditable. Manhattan College 230 transcript shows 18 credits of economics.

The CR 230 is the Manhattan College transcript showing 18 CR of economics:
24-201 and 202 Principles and Policies (6)
24-305 and 306 Monetary Economics et al (6)
24-431 Price Analysis (3)
24-433 Econometrics (3)
The course descriptions are on the CR33,34.
CR43 shows the calculation of estimating equations and betas in the econometrics course. This proves the involvement of computer software in the computational dimension of the econometrics course. This brings the running total from 30 to 48 credits.
General Psychology 203 on CR 230 and 35 is also creditable as biological sciences.
The catalog states: CR 035

"203. General Psychology. The science of behavior and experience; topics include approaches to psychology, growth and development, motivation, emotion and adjustment, learning memory, perception and thinking, individual differences and their testing: application of psychology to personal and social problems".

Topics in Science 70-203, 204 (6CR) was taught at Manhattan College by Dr. Macri of the Department of Chemistry.
Dr. Macri forwarded to the Director of OED CR 485- 494 on Department of Chemistry stationery CR486 and CR487.
Analytic Chemistry is covered in chromatography CR489 ₱59, Inorganic Chemistry is covered in the transition elements and inert gases CR490 ₱104,106, Environmental Chemistry is covered on CR490₱106, Advanced Inorganic Chemistry is covered with catalysis CR491₱25 and Physical Biochemistry is covered in radiation emission CR489 ₱43.

Environmental chemistry is covered on the CR 490 R106-108; R111, 112. The topics of environmental chemistry covered are sulfur and nitrogen pollutants, solid separation, oxidation of SO3, the exhaust manifold reactor and nitric oxide emissions and recycling. These topics are significant to PTO practice because they involve pollution control devices which is a fast-growing area of patent practice. In addition, government emphasis and regulatory standards for emissions is a very critical area of public policy domain.

The overall review of Manhattan College was last done by NYS in 1989 as per Donald J. Nolan of the Division of Evaluation in NYS. He communicated this information to Judge Harris 93-226 SSH,PLF in a letter dated 3-15-1994 DDC Proceedings R27. Portions of the letter follow:

> "However, all institutions are required to undergo an intensive on-site compliance review by Department staff and expert consultants about once every 5 years. These reviews include an examination of academic materials, and records, inspection of facilities, and interviews with students, faculty and administrative staff...
> Its most recent on-site visit was 1989."

This is in reference to the inspection of Manhattan College under NYS 3.47 and the Commissioner's Regulations governing degrees and evaluation of degree-granting institutions in NYS.

Education content is a state function. The decisions by the PTO personnel which address shades of level of course difficulty, technical vs. non-technical, science v. non-science, the definition of science itself, coursework which duplicates matter already credited and other judgments involve an encroachment on states' prerogatives in educational matters.

Relevant state cases are:
Sheldon College v. State Board of Education
48 NJ 501, 226 A 2d 612, 1967

This case upheld the principle that licensing may be done by those providing the training.

Tecumseh School District v. Throckmorton,
194 Ka 519, 195 Kan 144, 403 P 2nd 102('65)

Where the authority has been granted by state constitution, it may not be withdrawn.

Spaulding v. Illinois Community College Bd
64 Ill. 2d 499, 356 NE 2d 339

A state's interest in education has been considered so pervasive that it may act virtually at will.

School District v. State Board of Ed
176 Neb 722 127 NW 2d 558 (1964)

The trend has been to accept broader delegations, particularly where technical complexity and diversity require more generalized standards.

The Proceedings Below

The DDC failed to cite the computer sciences portion of the law on CR060. The previous argumentation delineates how over 40 credits is obtainable by reference to this law. The Appeals Court made an even bigger error by failing to cite the Computer Applications Advanced Professional Cert. earned at NYU and by erroneously omitting the Bachelor of Science designation. Both Courts gave too much undeserved deference to previous court precedents. The reference to Hines on Behalf of Sevier v. Secretary of HHS is a child measles case. Besides, HHS has placed the name of Joseph S. Maresca on its consultant file for computer sciences. In addition, HHS operates with control group data and scientific validations absent in the unvalidated job analysis or non-existent job analysis of the PTO. Clearly , the deference to the Hines on Behalf of Sevier case is unearned by PTO. PTO must present a scientific validation of the job steps to earn the right to attach itself to the Hines on Behalf of Sevier v. HHS 940 F. 2nd 1518, 1528 Fed Cir. 1991. The lower courts erred by not probing into Griggs v. Duke Power and U.S. v. Georgia Power to affix the burden of proof with regard to job required education content on the PTO. The lower courts accepted every subjective determination of the PTO un-cross referenced to any model syllabus, curriculum or professional literature-anywhere. The petitioner's arguments are all attached to either the Institute of Industrial Engineers, syllabi, model curriculum or professional literature.

Note that the letter from Donald Nolan references "expert consultants" in the examination of Manhattan College. The Anderson v Liberty Lobby Inc case cited by the respondents is inapplicable to the PTO or its determination of educational content. The Camp v Pitts case deals with the organization of a national bank. Cupples v. Marzall deals with grading of exam papers not in question here. Florida Power and Light Co v. Lorion deals with the appellate jurisdiction with regard to Nuclear Regulatory Commission decisions which request a proceeding. NRC jurisdiction is not in question here. PTO cites the MVMA v. State Farm Mutual Insurance Co to help prove its case. This is a transportation case and not a PTO case. Besides, the rational connection between facts and the judgment enunciated in MVMA v. State Farm Mutual Insurance Co is absent here. The rational connection between facts and the law is provided by the petitioner- not the respondents. The petitioner proves his case by reference to the 1991 law, independent /outside experts, professional literature and professional societies promulgated to set standards. In addition, the petitioner's professional licenses, prior teaching, prior patenting, assessment of his knowledge by the National Science Foundation distinguish materially from Gager v. Ladd which is out-of-date as to modern human resource evaluative standards.

II. The List of Parties Whose Judgment Is Being Questioned

The parties whose judgment is in question are the Commissioner, Director of OED, Director of Interdisciplinary Programs, any intermediary level liaisons, the U.S. Court of Appeals for the Federal Circuit and the District Court for the District of Columbia. The constitutionality of 37 CFR 10.7 and 35 USC 31 is being called into question because the states clearly have residual powers and exclusive authority in the area of determining educational content. Congress must recognize that determining qualifications does not also give permission to the Director of OED to question education content once the States have defined that content in formal degree programs and review processes of those degree programs.
The Court should look to a theoretical accounting concept for substantial authoritative support. The accounting concept for substantial authoritative support assigns a hierarchy of importance with the professional society atop the hierarchy. Other portions of the hierarchy are opinions of the professional society, professional literature, educational institutions etc. This hierarchy allows every decision to be mapped to a particular standard or issued professional literature as support for conclusions. This is not so with the PTO. The PTO does not map experts to the required expertise for each application. For instance, a chemistry person may make pronouncements with regard to industrial engineering or computer science and do so without reference to a formal syllabus, curriculum or cited expert witness in the art of the application before the PTO. Every statement made by the appellant is mapped to authoritative support derived from the relevant professional literature.

The pronouncements made by the Director of OED are all subjective. They are not retraceable. The Director of OED uses no syllabus or model curriculum. There is no job description for a patent agent nor is there a validation of the individual tasks performed by a patent agent. Since the requirements were never subjected to a professional validation by a human resources expert, the law itself has always been unvalidated- even the most recent attempt at a re-write of the law is unvalidated. The law was re-written during the pendency of the 93-226 DDC case involving Joseph S. Maresca v. Commissioner of Patents. At or in proximity to the U.S. Attorney response, the law was changed to exclude even scientific matter. The final status of this law is under consideration by the Congress at the present time. In the interim, the appellant seeks equitable relief from the Supreme Court to order him into the Patent Exam or to allow more than the 3 of 37 credits awarded by the PTO. The order should address the separation of powers issues between determining qualifications and mandating educational content which is a state prerogative. The Supreme Court should consider the lack of standardized tools by the Patent Office. Formal job descriptions, validations of the job descriptions, model curriculum and model syllabi must be present to ensure consistency and retraceability of the decisions of the Director of OED. The process of validating the education requirement might yield a conclusion that the exam itself is all that is required. The patent agent exam tests chemistry, electronics and mechanical processes in the essay portion of the patent agent exam. Historically, exam candidates choose 1 of 3 questions from a chemistry claims writing question to an electronics question to a mechanical claims writing question.

The entire process of evaluation by the Director of OED may be unnecessary. To avoid ignoratio elenchi, a professional human resources expert should be engaged to prove that this is the case scientifically and by use of control groups tested uniformly and evaluated the same. The method of controlling the number of passing candidates is by reliance on the exam curve and not by screening out qualified candidates. In the Accounting Profession, the law portion of the exam has had an 18% passing rate with 40% passing the auditing section and 25% passing the practice section. This passing rate contrasts to the nearly 2/3 passing rate on major portions of the patent exam. Assuming that the PTO wishes to have fewer Patent Agents and Attorneys, the proper approach would be to administer a tougher exam .

Under separate cover, a VCR tape containing a Con Edison Electric ad was forwarded to the Court by the petitioner with instructions to "lodge it". This ad was placed on various television channels. On the date the Appeals Court released its opinion (5-8-95), Channel 5 ran this ad. Con Edison is represented on the Manhattan College Board of Directors. The Court is asked to review this ad to determine whether or not the PTO or the lower courts may have been influenced by it.

The Court is asked to examine very carefully the opinions of the PTO personnel including the Solicitor. These opinions are merely interpretations of the law and they do not carry the weight of properly promulgated rule making. They are non-binding because they only set forth what the agency believes existing laws or regulations to mean. Courts should not treat unvalidated provisions of the General Bulletin as though they were properly promulgated under the Administrative Procedures Act.
The PTO issuances are not signed by the Commissioner nor is he/she cc'd (copied on them) . As a result, it is not clear where the decision-making process begins or ends. In addition, the work product of the Director of OED is not made publicly available. This is significant because applicants don't know how conclusions were reached. By implication, such conclusions cannot be independently replicated utilizing classic tools of evaluation in academe, the professions or industry itself. The opinions rendered in the Court of Appeals mirror these weaknesses. The courts affirm past precedents that do not apply. The appellant refuted every case cited by the courts methodically showing that none of the cited cases apply here. Unlike the Sperry v. Florida case, this case involves the state determination over education content not patents.

III Concise Statement Concerning a Referral of Case to the Supreme Court

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There are outright errors in the lower court omission of the relevant 1991 law regarding Cat B Option 4 computer sciences and engineering in nature credit on the certified record 0060. Judge Friedman cited the law on the certified record 0059 but omitted the law on the certified record 0060.
The law on the certified record 0060 deals with computer sciences credit and engineering in nature credit including algorithms, computer fundamentals, software with lab, operating systems, computer architecture and theoretic models/representations.
For instance, the Manhattan College 45-408 course is a Quantitative Models course with classic algorithms on the certified record 166, 167, 169, 170-1, 448 registrar statement to the OED Director.
In addition, there are a myriad of constitutional issues which are properly decided by the Supreme Court. The dividing line between determining qualifications and mandating educational content is not clear. Which area of the government has the final jurisdiction?
In addition, there is no continuous constitutional precedent for the PTO to be housed in the Commerce Department. There is no clear precedent from the Supreme Court for a Patent Office case which deals with determining educational content. The existing precedents deal with other federal agencies or other issues outside the scope of this lawsuit.

A Supreme Court decision in this case would help to clarify the role of the PTO for other candidates and as a citable precedent. Since the entire reorganization of the PTO is pending in the near future, an opinion from the Supreme Court would assist legislators in reframing the legislation properly.

The Supreme Court has jurisdictional review power when outright errors have been committed by the lower courts as in this case. The Supreme Court may send any case back to the lower courts with instructions to reconsider the same case with new guidelines. In addition, the Supreme Court has jurisdictional review over the 10th amendment which covers residual powers with regard to education in the appellant's case.

The 10th amendment sets forth the following:

> "The powers not delegated to the United States by the Constitution nor prohibited by it to the States, are reserved to the States respectively or to the people."

There is an entire body of state case law argued earlier in support of the 10th amendment. In addition, the Department of Education Organization Act provides:

> "The establishment of the Department of Education shall not increase the authority of the federal government over education which is reserved to the states and the local school systems and other instrumentalities of the states".
> Source: 20 USC Par 3403(a)

Lastly, the Supreme Court may rule on the concept of substantial authoritative support for a position taken by the PTO. Does such authoritative support require an expert in the technical matter of the application, a standardized syllabus, standardized curriculum, professional literature or a combination?
Does the job of a patent agent require a job description and validation of that job description to satisfy past decisions of the Supreme Court which place the burden on employers to show qualifications related to the actual work flow or to actual decision-making processes encountered on the job?

IV Material Facts Presented For Review

Appellant, Joseph S. Maresca presents the following set of material facts to be reviewed.

1. The certified record of the lower court 0060 contains the portion of the law as at October 28, 1991 omitted in the 12-23-94 decision by Judge Paul Friedman. Inclusion of this law would resolve the additional 37 credits for entrance into the PTO exam for patent agents. The lower court recited the portion of the law not applicable to the candidate and omitted the portion applicable.

The portion of the law which applies to the candidate and represents a genuine issue is as follows: Certified record 0060

> "Also, under Option 4, computer science courses which are computer engineering in nature will be accepted. Such courses would include courses that provide in depth knowledge of computer science, including digital computer system architecture and system software organization, the representation and transformation of information structures, and the theoretical models for such representations and transformations. Accepted courses would include linear circuits, logic circuits, networking, fundamentals of computer science, algorithms, data structures, software design with a lab, programming languages with a lab, operating systems and computer architecture." 37 CFR 10.7 10/91 Application

The documentation for the appellant's Cat B Option 4 credit is contained from pages 1-821 in the lower court record of the District Court of the District of Columbia. The Brief on the Merits will sort through this record for the Court. The lower court record was presented in many cases in individual folders for each course. The government photocopied the original record out of order and this makes for a very difficult review.

Cat B Option 4 excludes matter from consideration as scientific and technical training. Specifically, it excludes math courses, non-science courses and economics of technology. The exclusion of math courses contradicts the published hiring for patent examiners requesting 30 credits of math, statistics and computers discussed earlier. The law states (in part):

> "The following courses are not accepted as demonstrating scientific and technical training: science courses for non-science majors, math courses...economics of technology, courses in the history of science ..."

At least 18 credits of Other Than Economics of Technology courses are on the Manhattan College transcript of the appellant.
Economics of technology is excluded but matter which is not economics of technology is not excluded.
That which is not economics of technology is macro-economics or economics which considers variables and factors beyond technology only.

For instance, macro-economics considers the entire economy; whereas, economics of technology considers only a single dimension of the economy. Consideration of macro-economic variables is important because a patent application must identify sources of supply to build and recreate the invention. Accordingly, the demand/supply of component parts is an important factor in establishing that materials exist to recreate what has been set forth in the patent.

The appellant presents a Manhattan College transcript for review and an NYU transcript for review on the lower court certified record 230 and 0151 respectively. Both of these transcripts in combo contain the 40 credits of Cat B Option 4 computer sciences which is engineering in nature. Both transcripts also contain Cat A-Industrial Engineering credit as discussed on Brief pages 30-33 of the 1-18-94 Appeals Court Brief and Vol I-IV submissions. Cat B Option 4 credit is argued extensively on the appeals court brief pp 1-15 filed 1-18-1995.

The appellant presents an issued patent on the lower court certified record 475. In addition, the appellant presents a review of a proposal from the National Science Foundation which addresses the appellant's patent knowledge of artificial intelligence of computers from the perspective of a National Sciences Foundation reviewer. This National Science Foundation review is contained in the 2-2-93 submission to the District Court for the District of Columbia brief and appendix pp. 92.

The portions of the reviewers comments which deal with computer science patenting of artificial intelligence are as follows:

"Title: Expert Systems Development

1. The PI seems to have considerable experience in studying expert systems and computer systems to handle them. A strength of this proposal is his fairly unique in depth experience in studying AI patents."

The overall rating by the reviewer is good.

This review by the National Science Foundation reviewer establishes an independent assessment outside the PTO together with the appellant's patent on the certified record 475. The Brief on the Merits will contain the detail of individual courses sought for credit under the 37 CFR 10.7 (1991 law). The appellant will cite some blatant and material errors to help prove the case in the Writ. These are just a few of the material errors. There are many more.

B20.2312 Introduction to Systems Analysis and Design is a 3 credit course listed on the DDC Proceedings 8-Certified Record 0151 and 329. The course catalog on certified record 0153 states the following:

"Introduction to Systems Analysis and Design
B20.2312

Explains the concepts, methods and techniques used in the analysis and design of information systems. Topics include system life cycle, data flow diagrams, file layout and processing design, input and output forms/screen layout, skeleton systems, cost-benefit analysis, interviewing, job design, and report and documentation contents. Opportunities are provided to use techniques in practice. Some group work is required."

Certified record 0151 is the NYU transcript. Certified record 329 is the course syllabus and certified record 0153 is the NYU course catalog. The Burch and Stratter book is listed as the course required text on the certified record 0329. Samples of the Burch and Stratter text are on the certified record 0330-343. On certified record 331 alone, early in the Chapter 3 is coverage of networks, the metanetwork, network topologies, star and hierarchical network topology, ring and bus network topology etc. This is classic Cat B Option 4

37 Cat B Option 4 says that:
"Accepted courses would include linear circuits, logic circuits, networking, fundamentals of computer science, algorithms, data structures, software design with lab, programming languages with lab, operating systems and computer architecture."

Networking, operating systems and computer architecture is found throughout the Burch and Stratter text and particularly on the certified record 0331 above. Data structures,schemas and subschemas, networks and trees is again referenced extensively on the certified record 337. This course was not credited by the PTO.
On the Proceedings of the DDC 8-certified record 46, the appellant's syllabus is listed. The syllabus shows that 10 sessions of the BASIC language were taught together with computer operating systems, telecommunications equipment, systems design of all major manufacturing modules including engineering, manufacturing and physical distribution. This course was not credited by the PTO. The course covers intensive software programming with lab, computer architecture and engineering systems.

The certification standards of the Computer Sciences Accrediting Board (1995) are generally known to the PTO. These standards govern undergraduate degrees only because the Board is still in its infancy. It does not yet certify graduate school programs in Computers in the U.S. Nonetheless, its Cat A Computer Science requires proficiency in at least one-higher level structured language. The Appellant's teaching at the Manhattan College on the certified record 46 covers this requirement. The PTO has already credited NYU B10.2207 which covers FORTRAN computer programming. The combo of these 2 courses gives 2 computer programming languages. The Computer Sciences Accreditation Board (1995) lists only examples of advanced areas to include:

"Examples of advanced areas include algorithms and data structures, artificial intelligence and robotics, computer networks, computer organization and architecture, database and information retrieval, human-computer communication, numerical and symbolic computation, operating systems, programming languages, software methodology and engineering and theory of computation."

All of the cited criteria of the Computer Science Accrediting Board are embodied in the NYU Advanced Certificate Program on the DDC Proceedings 8- Certified Record 0151.

Additional requirements of the Computer Science Accrediting Board are at least 1/2 year math and 2/5 year science. The Manhattan College transcript on the DDC Proceedings 8- certified record 230 shows math for math majors including calculus through ordinary differential equations, linear algebra, probability and stat inference. This is a vast overkill. The science requirement is covered by Topics in Science 70-203, 204 together with the passing of the NYS Experimental Biology, Chemistry and Physics referenced in various portions of the cert. record. NYS administers standardized regents exams in the three sciences. The appellant has passed all 3 standardized experimental biology, chemistry and physics. The humanities requirements of the Computer Sciences Accrediting Board standards are covered on the Manhattan College transcript with courses in literature, speech, history, philosophy, theology, logic etc.

The Supreme Court may accept the published criteria of the Computer Science Accrediting Board to impute Cat. B Option 4 computer sciences credit.

56-204 Ordinary Differential Equations on the Manhattan College transcript 0230 covers Euler and La Place Transformations. This is theoretic physics coverage.

Network algorithms are covered in the Manhattan College courses 45-407, 408 Operations Research and Quantitative Models. The certified record 448 references the use of the Wagner text. The certified record 0172 shows network algorithms, theoretical models (Advanced techniques for waiting line models) etc. These 6 credits on the Manhattan College transcript together with the prerequisite 45-307 course represents 9 credits under the "algorithms" caption of Cat. B Option 4. The purpose of the Writ is not to win the case at the outset. It is to show enough detail to interest the Court in the merits of the case and the constitutional issues present.

In arguing the merits of this case, the Gager v. Ladd which is cited by Judge Friedman doesn't apply. The appellant has taught in the art of the application in the Category B Option 4 certified record 45, 46. The course in Concepts of the Computer is an intensive coverage of BASIC programming which covers the Cat B Option 4 Software Programming with lab requirement. In addition, the appellant has patented in the geophysics art. This is depicted in the earthquake monitoring device-Pat. 5, 075, 857, '91, MARESCA.

The National Science Foundation has acknowledged the appellant's knowledge of artificial intelligence patents on page 92 of the DDC lower court informal brief appendix. The law has changed various times since the Gager v. Ladd ruling. A job description for a patent agent does not exist and there is no validation of the education requirement. The U.S. Attorney readily admits this fact. The omission of these basic human resource standards contradicts materially the ruling of the Supreme Court in Griggs v. Duke Power, U.S. Reports, 1971, 401, 424(a) wherein;

> "Congress has placed the burden of showing that any given requirement must have a manifest relationship to the employment in question. Professionally developed tests must be job-related."

This standard of review overcomes the Gager v. Ladd citation. In addition, the lack of a job description for a patent agent shows that the Supreme Court's 1971 ruling takes precedence over the Gager v. Ladd ruling. In addition, the Supreme Court's 1971 ruling comes in the next decade following the Gager v. Ladd ruling.

Since the lack of a validation of the job steps for a Patent Agent creates an ambiguity, the ambiguity should be resolved in the disfavor of the party creating the ambiguity. The party creating the ambiguity is the PTO. Therefore, the PTO should suffer the loss. It is the PTO who has argued ignoratio elenchi. The party initiating the ignoratio elenchi argument must prove that argument logically and by reference to evidence as against subjective statements and judgments which lack antecedent basis.

The work flow has been the historical point of reference for setting industrial standards. The work flow of the PTO contains many business process patents; such as,

- Interactive Market Management System
  Pat 4, 799, 156, Jan. 1989, Shavit
- Pension Benefits System
  Pat 4, 750, 121, 6/88, Halley
- Securities Brokerage Cash Management System
  Pat 4, 774, 663, 9/88, Musmanno

The Supreme Court should recognize that the patent practice law incorporates by reference the work flow of the PTO. All of the above patents were on the PTO live issued files long before this lawsuit. The Director of OED cannot claim to be uninformed as to the work flow through the PTO and the impact on allowable academic coursework which reflects or amplifies the work flow. In the instant case, the 18 credits of economics reflects the work flow of the PTO. It is other than economics of technology and therefore allowable as Cat B Option 4 credit.

Other Interested Parties

The Committee on Courts and Intellectual Property of the House of Representatives is an interested party because it is in the process of formulating HR 1732 Patent Reauthorization Reform Act. Hearings were held on various dates in September, 1995. This party will be requested to file an amicus curiae brief. Other interested parties are the NYS Education Department, the education departments of the various states, the Institute of Industrial Engineering, the Computer Sciences Accreditation Board, the European Patent Office, Manhattan College, New York University, the American Institute of CPAs (prior institutional employer), the Information Systems Audit and Control Assoc.

In addition, there is at least one similar case in the United States Court of Appeals for the Federal Circuit. This pending case has not been decided by the Federal Circuit; however, a ruling in this case may obviate the necessity for this undecided case and others like it.

Concise Reasons for Amplifying the Writ

1. The United States Court of Appeals for the Federal Circuit has decided the case 95-1146 Joseph S. Maresca v. Commissioner of Patents on issues which should be decided by the Supreme Court. The "residual powers issues" concerning whether or not the states are the ultimate arbiters of educational content are properly decided by the Supreme Court. By deciding in favor of the respondents, the United States Court of Appeals has over-extended its jurisdiction.

2. The United States Court of Appeals for the Federal Circuit has relied upon very old and inapplicable case law. Every case cited by the respondents was refuted methodically in this Writ. Gager v. Ladd is very old case law. It needs to be updated.
In addition, the 37 CFR 10.7 and 35 USC 31 have changed or been re-written over the years. A decision by the Supreme Court to take this case and render a decision would update the case law and discourage unnecessary lawsuits by clarifying the hierarchy of legal principles. For instance, does State law take precedence over a contradictory federal law as is the case in the contradiction of NYS Law 3.47 with regard to technical content in earned degrees. In addition, does the PTO interpretation of technical content prevail over professional societies and/or the relevant professional literature?
The Supreme Court could clarify rule structures to force the PTO into supporting its conclusions with analytic rules rather than subjective statements which seem to abound. Is it necessary to utilize a syllabus and model curriculum in analyzing applications?

Should the analysis of the Patent Office shown on the certified record contradict its own Personnel Hiring Office?

Should the analysis of the PTO on entrance applications contradict the issued patent work flow? i.e. Does the Director of OED ignore the work flow of the allowed patents as in determining to award academic credit under Cat A or Cat B Options?

3. The United States Court of Appeals has decided the case 95-1146 of Joseph S. Maresca v. The Commissioner of Patents without consideration of the ruling by the Supreme Court in Griggs v. Duke Power, U.S. Reports , 1971, 401, 424(a). In this case, job relatedness of mandated requirements is affirmed and the onus is on the employer to show the need. In addition, the U.S. v. Georgia Power Co. case of the Fifth Circuit Court of Appeals '73 decided that a company's validation study wasn't relevant in the instance where it did not correspond to the actual decision-making process by which applicants were employed. In the instant case, there is also a PTO Vacancy Announcement 94-008 which contradicts the position taken by the Director of OED. The appellant qualifies under this announcement and he still has received 3 of 40 credits whereby the announcement would award 30 of 40 credits minimally. This announcement is for computer sciences patent examination practice.

Petitioner-Pro Se

APPENDIX

United States Court of Appeals for the
Federal Circuit

ORDER

Before ARCHER, Chief Judge, RICH, Circuit Judge
and Lourie, Circuit Judge

A petition for rehearing having been filed by the APPELLANT, UPON CONSIDERATION THEREOF, it is ordered that the petition for rehearing be, and the same4 hereby is , DENIED.

The mandate of the court will issue on June 29, 1995 unless another timely petition for rehearing is filed within the time permitted by RULE 40.

Dated June 12, 1995

For the Court
Francis Ginhart
Clerk

//s
by Diane Frye
Chief Deputy
Clerk

cc: Joseph S. Maresca
Nancy J. Linck

MARESCA v. COMMISSIONER , 95-1146
DCT- 93-226

Note: Pursuant to Fed Cir R. 47.6, this order is not citable as precedent. It is public record.

United States Court of Appeals for Federal Circuit

95-1146

Joseph S. Maresca
Plaintiff-Appellant

v.

Commissioner of Patents and Trademarks
Defendant-Appellee

Judgment

On Appeal from the U.S. District Court
District of Columbia
in Case Nos. 93-226

This cause having been heard and considered it is ORDERED and ADJUDGED

AFFIRMED

ENTERED BY THE COURT

Dated May 8, 1995 Francis X.Ginhart, Clerk

Costs:Against,Appellant
Printing $167.90

ISSUED AS A MANDATE: July 6, 1995

Note:Pursuant to Fed.Cir R 47.6, this disposition is not citable as precedent . It is public record. The disposition will appear in tables published periodically.

United States Court of Appeals for
Federal Circuit

95-1146

JOSEPH S. MARESCA,
Plaintiff-Appellant,

v.

COMMISSIONER OF PATENTS AND TRADEMARKS
Defendant-Appellee

DECIDED May 8, 1995

Before ARCHER, Chief Judge, RICH and
LOURIE, Circuit Judges
LOURIE, Circuit Judge.

DECISION

Joseph S. Maresca appeals from a decision of the United States District Court for the District of Columbia. The court upheld on summary judgment the decision of the Commissioner of Patents and Trademarks ("Commissioner") denying Maresca admission to take the examination for registration to practice before the U.S. Patent and Trademark Office ("PTO"). Because the district court properly granted summary judgment for the Commissioner, we affirm.

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DISCUSSION

On October 28, 1991, Maresca filed with the PTO a request for admission to take the April 1992 patent practitioner's examination. The Commissioner denied his request on the ground that he lacks the qualifications necessary to take the exam as set by applicable PTO guidelines. Maresca possesses a bachelor's degree in business administration. The Commissioner determined that Maresca does not meet the PTO's "Category A" qualification criterion because he lacks a bachelor's degree or its equivalent in engineering, biological science or physical science. The Commissioner further determined that Maresca does not meet the PTO's "Category B" criteria because he has earned only three of the required forty semester hours in chemistry, physics, biological science, or engineering, and he has not taken a minimum of eight semester hours in chemistry with a lab or physics with a lab.

Maresca filed a civil action pursuant to 35 USC Par 32 in the U.S. District Court for the District of Columbia, challenging the Commissioner's decision. The court,after reviewing the administrative record, granted the Commissioner's motion for summary judgment and denied Maresca's cross-motion for summary judgment. The court held that the Commissioner did not abuse his discretion in denying Maresca's request to take the patent practitioner's exam and that the Commissioner had considered the relevant evidence of record, drawn plausible inferences, and articulated a rational basis for his decision.

The court further held that the Commissioner's decision was fair and reasonable and not arbitrary or capricious. Maresca now appeals.

We have carefully reviewed the record and the district court's decision, as well as Maresca's arguments, which we need not repeat. We find no error in the court's grant of summary judgment for the Commissioner. On the contrary, we are fully persuaded that the court thoroughly considered the record before it and properly granted summary judgment. The District court's decision is affirmed.
95-1146

United States District Court for the
District of Columbia

JOSEPH S. MARESCA)
Petitioner
v.
COMMISSIONER OF PATENTS AND TRADEMARKS
et al. Respondents)

Civil Action No. 93-0226 PLF

FILED 12-23-94
Clerk, U.S.District Court
District of Columbia

Memorandum Opinion

Joseph Maresca challenges the Patent and Trademark Office's ("PTO") decision denying his application to take the examination for registration to practice before the PTO. Before the Court are petitioner's motion for summary judgment and respondent's motion for summary judgment. The Court finds that there are no genuine issues of material fact and that judgment should be entered for respondents.

I. BACKGROUND

On October 28, 1991, Mr.Maresca filed with the Office of Enrollment and Discipline ("OED") a request for admission to the April 1992 Patent Practitioner's examination. On December 17, 1991, the OED disapproved Maresca's application because he did not meet the requirements for admission to the examination. AR 55-63

Before being allowed to take the patent practitioner's examination, an applicant seeking the right to practice before the PTO must establish to the satisfaction of the Director of OED that he or she "possess(es) the legal, scientific, and technical qualifications necessary to enable him or her to

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render applicants for patents valuable service. 37 CFR 10.7(a)(2)(ii). The PTO publishes a bulletin, called the General Requirements for Admission to the Examination for Registration to Practice in Patent Cases before the U.S. Patent Office, that sets out three ways an applicant can show that he or she meets the scientific and technical qualifications for admission into the examination. AR 57-63

Under Category A, the applicant may show that he or she has received a a bachelor's degree, or an equivalent degree, in one of 29 listed technical disciplines. AR 59

Under Category B, an applicant may show that he or she has taken (1) 24 semester hours in physics courses for physics majors, (2) 24 semester hours in biological sciences courses for biological sciences majors and eight semester hours of chemistry with a lab or 8 semester hours of physics with a lab for chemistry, physics or biological science majors, or

continued on next page

(4) 40 semester hours of chemistry, physics, the biological sciences or engineering, including at least eight semester hours of chemistry with a lab or eight semester hours of physics with a lab. AR 59-60

Under the fourth option, science courses for non-science majors, astronomy courses and mathematics courses are not accepted. Under the fourth option, up to 16 semester hours may be credited based upon a showing of scientific and technical training gained through a long apprenticeship with a registered patent attorney or patent agent. AR 60 Under Category C, an applicant may show that he or she has taken and passed the Engineer in Training test. AR 60.

Mr. Maresca possesses a Bachelor of Science in Business Administration. To support his application he submitted college transcripts and papers describing the courses he had taken. AR 25-54

continued on next page

He sought to show that he qualified under Category A because he claimed he had the equivalent of an Industrial Engineering degree. Mr. Maresca also sought approval under Cat B Option 4. He claimed that he had the requisite 40 semester hours because he should receive credit for courses including Topics in Science, Concepts of the Computer, General Psychology, Quantitative Analysis, Operations Research, Business Policy, Price Analysis, Econometrics, Ordinary Differential Equations, Linear Algebra, Introduction to Systems Analysis and Design, Advanced Systems Analysis, Policy Studies Thesis and Social Consequences of Information Theory. The OED found that Mr.Maresca did not have bachelor's degree or its equivalent in engineering, biological science or a physical science listed in Cat A. It also found that Mr.Maresca's courses failed to provide the necessary scientific and technical training to meet the requirements of Cat B Option 4. AR 55-56 The OED found that Mr.Maresca had not shown that he had taken eight semester hours of chemistry or physics with lab; rejected petitioner's computer, mathematics, economics and psychology courses; and declined to give credit to Maresca for prosecuting a patent application pro se (underlined) because he did not show a long apprenticeship with a registered patent attorney or patent agent.

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Mr. Maresca requested reconsideration and submitted additional materials to the OED on January 2, 1992 (AR 64-78) on January 6, 1992 (AR 82-123), on January 20, 1992 (AR 127-253), and on March 2, 1992 (AR 259-427). The Director of OED maintained his refusal to register petitioner. AR 79-81, 124-6 255-58, 428-30. On April 14, 1992, Mr. Maresca again submitted additional materials and, pursuant to 37 CFR P 10.2c petitioned the Commissioner for review. AR 434-683. The Commissioner denied the petition for review and later denied petitioner's request for reconsideration. AR 684-93, 694-811, 812-22. (Footnote 1) Petitioner subsequently filed this action under 35 USC Par 32 and Local Rule 213.

In his July 31, 1992, Decision on Petition for Review, the Commissioner through his designee, the Director of Interdisciplinary Programs, found that the Director of the OED did not err in finding that Mr. Maresca had not met the requirements of Cat A or Cat B, Option 4, of the PTO Bulletin. AR 684-94

The Commissioner upheld the Director's decision to give credit for only three semester hours and to deny credit for the other courses that Mr. Maresca submitted as meeting the requirements of Option 4. He found that the Director properly concluded that neither petitioner's Topics in Science course nor certain high school science courses fulfilled the requirement that petitioner show he has taken eight semester hours of chemistry with a lab or eight semester hours of physics with a lab;

that the Director correctly denied credit for Mr. Maresca's Concepts of the Computer course because the subject matter was the same as the Advanced Professional Certificate course for which petitioner had already received credit; that the Director correctly denied petitioner credit for his Linear Algebra course because the bulletin expressly states that mathematics courses are not accepted as demonstrating scientific and technical training; and that the Director properly found that petitioner should not receive credit for his other courses as allowable science or engineering courses because they were either liberal arts, business or non-science courses. AR 689-91

Footnote 1

Before the OED could respond to petitioner's last submission and request for reconsideration, he filed an appeal in the United States Court of Appeals for the Federal Circuit. The appeal was dismissed because the appeal was premature and the Court lacked jurisdiction. AR 712.

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In addition, the Commissioner found that petitioner had failed to show that he was entitled to 16 hours of credit for an apprenticeship because he did not identify with which patent applications he had assisted and did not provide a statement from a registered practitioner under whom petitioner served. AR 691-92.

In his January 4, 1993, Decision on Request for Reconsideration, the Commissioner, through his designee, the Director of Interdisciplinary Programs, rejected Mr. Maresca's argument that his coursework is a bachelor's degree in a field equivalent to industrial engineering and therefore qualifies him to take the examination under Cat A of the PTO Bulletin. AR 812, 814 -815 . The Commissioner stated that Cat A contains no provision for admission to the examination on the basis of the applicant showing he has a bachelor's degree in a field that is "equivalent" to a subject listed in Cat A. Rather, the term "equivalent" modifies bachelor's degree; the applicant must have a bachelor's degree or the equivalent of a bachelor's degree in one of the listed fields. AR 815 The Decision also reiterated that the Director had properly concluded that petitioner had not met the requirements under Category B, Option 4, of the bulletin. AR 815-821

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II. Analysis

The Commissioner of Patents and Trademarks, and not the courts, is vested with the responsibility to protect the public from unqualified practitioners before the Patent Office. Leeds v. Mosbacher, 732 F.Supp 198, 200 DDC (citations omitted), aff'd mem., 918 F. 2d 185 (Fed . Cir. 1990). To fulfill this responsibility, the Commissioner may determine whether a petitioner seeking to represent applicants for patents is qualified to practice before the PTO. 35 USC 31 see also 35 USC Par 6; 37 CFR Par 10.7
This court may disturb the commissioner's decisions regarding a potential representatives qualifications only if it finds that the Commissioner abused his discretion in denying a petitioner's application. The court may find an abuse of discretion if the commissioner's decision was arbitrary and capricious. Gager v. Ladd 212 F Suppl., 671, 673 DDC 1963

Under 35 USC Par 32, the sole basis for the Court's review is the record and proceedings before the PTO, see Local Rule 213, and the Court's limited function is to determine whether the PTO's decision was arbitrary and capricious based on the record created and considered by the PTO. Camp v. Pitts, 411 U.S. 138, 142 (1973); Leeds v. Mosbacher, 732 F. Suppl. 204.
This standard of review is highly deferential: " If (the Commissioner) has considered the relevant evidence of record, drawn plausible inferences and articulated a rational basis for the decision, reversible error will be extremely difficult to demonstrate."
Hines on Behalf of Sevier v. Secy of the Department of HHS, 940 F. 2d 1518,1528 (Fed Cir. 1991) (citations omitted).

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In this Court, Mr. Maresca advances essentially the same arguments with respect to his qualifications under categories A and B that he made before the Director of OED and the Commissioner. The Court has carefully considered these arguments and the arguments of counsel for the Commissioner, and has reviewed the record before the OED and the record before the Commissioner, the decisions of the Director of OED, the Commissioner's Decision on Petition for Review, and the Commissioner's Decision on Request for Reconsideration. The Court finds that the Commissioner did not abuse his discretion in denying Mr.Maresca's application. The Commissioner considered the relevant evidence of record, drew plausible inferences and articulated a rational basis for his decision. His decision was "fair and reasonable in light of all the facts and circumstances in the case..." Gager v. Ladd, 212 F. Supp at 674. Absent any other relevant considerations, therefore, the decision of the Commissioner must be upheld because it is not arbitrary and capricious. Leeds v. Mosbacher, 732 F. Supp. at 204; Gager v. Ladd 212 F. Supp at 674.

In his appeal to this Court, Mr.Maresca advances two new arguments. First, he argues that the Commissioner has not obtained an independent validation of the qualification requirements for the examination. He asserts that the PTO's decisions with respect to which of his courses should receive scientific or engineering credit are invalid because the PTO has failed to consider the outside opinions of professional associations that set scientific and engineering standards. Second, he argues that the PTO's decision is an invalid encroachment on states' rights because it impinges on New York's laws that set educational standards.

Mr. Maresca's additional claims lack merit. Congress delegated to the Commissioner the responsibility for setting the qualifications required of persons seeking to be registered to practice before the PTO. 35 USC Par 6, 31; Leeds v. Mosbacher, 732 F. Suppl. at 200. Congress did not direct the Commissioner to consult with independent standard-setting bodies or states in fulfilling his responsibility. Congress provided the Commissioner with the discretion to determine the necessary qualifications. He need not obtain approval from any state or independent organization in setting or applying the qualifications. (Footnote 2)

For the forgoing reasons, petitioner's motion for summary judgment is DENIED and respondent's motion for summary judgment is GRANTED. An Order consistent with this Memorandum Opinion is entered this same day.

SO ORDERED

Paul L. Friedman
United States District Judge

Date: 12-23-94

Note: It has long been settled that the standards established by the Commissioner are reasonable, definite, fair and objective. See Gager.v. Ladd, 212 F. Supp 673.

United States District Court
For The District of Columbia

JOSEPH S. MARESCA,
Petitioner,

v.

COMMISSIONER OF PATENTS AND TRADEMARKS, et al.
Respondents

Civil Action
93-0226 PLF

Filed 12-23-94
Clerk

ORDER

This case comes before the Court on Petitioner's Motion for Summary Judgment and Respondents' Motion for Summary Judgment. Upon consideration of the motions, the supporting and opposing papers, the entire administrative record in this case, and for the reasons stated in the Memorandum Opinion , it is hereby

ORDERED that the Petitioner's Motion for Summary Judgment is DENIED and the Respondents' Motion for Summary Judgment is GRANTED; and it is

FURTHER ORDERED that judgment is entered for Respondents.

SO ORDERED

//s

Paul L. Friedman
United States District Judge

Date:
12-23-94